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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,379	03/18/2004	Mitsuyoshi Onoda	7052/TOS	5500
3574	7590	11/06/2006	EXAMINER	
JOHN E. TOUPAL 116 CONCORD STREET FRAMINGHAM, MA 01701			ROE, JESSEE RANDALL	
			ART UNIT	PAPER NUMBER

1742

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,379

Applicant(s)

ONODA, MITSUYOSHI

Examiner

Jessee Roe

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Status of Claims

Claims 1-5 are currently under examination.

Specification

The specification is objected to because of the following informalities: (1) "evil" is used on page 3, line 4 and page 5, line 7 are used in a context in such a way that does not enable one skilled in the art to understand the meaning; (2) "lyer" is used in place of "layer" on page 3, line 18; and (3) a furnace is not referred to anywhere in the specification. Appropriate correction is required.

Claim Rejections

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3-4 recite the limitations "in-furnace" and "an oxidized scale film". There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Carey (US 5,491,036).

In regards to claims 1, Carey ('036) discloses a method for heat treating a material used to make a wire coil in a controlled oxygen environment (col. 8, lines 15-30 and col. 13, lines 34-59). The material is subjected to acid treatment in a pickling tank (col. 22, lines 56-68). The Examiner has interpreted scalping as a removal of a layer. The strength of the acids etches the surface of the material and removes a thin layer (col. 23, lines 1-15). After the material is exposed to the acid, the material is then passed through water (a lubricant) (col. 14, lines 9-38). The material is subjected to coating in a coating tank where an annealing process is undergone. After the material is coated, it is cooled with palm oil (oil temper treatment), and then coiled (col. 17, lines 9-20 and col. 15, lines 25-59).

In regards to claims 3-4, Carey ('036) discloses a method for heat treating a material used to make a wire coil comprised of exposing the material to air (oxygen and nitrogen) or inert gases such as nitrogen, carbon dioxide, hexafluoride, hydrogen, and noble gases upon exit of the coating tank (col. 15, lines 25-59). Addition of these gases is used to control the oxygen content.

In regards to claim 5, Carey ('036) discloses a method for heat treating a material used to make a wire coil comprised of silicon and chromium steel (col. 7, lines 9-28).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carey (US 5,491,036).

In regards to claim 2, Carey ('036) discloses a method for heat treating a material that is coated in a coating tank between 449 °F and 1000 °F (232 °C and 538 °C). The Examiner notes that claimed temperature range of 500 °C and 600 °C of the instant invention overlaps the disclosed temperature range within the coating tank of Carey ('036) (col. 8, lines 15-68). The Examiner notes that the disclosed heating temperature range of the material when coated overlaps with the heating temperature range of the claimed invention. Therefore, a prima facie case of obviousness exists. See MPEP 2144.05.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessee Roe whose telephone number is (571) 272-5938. The examiner can normally be reached on Monday-Friday 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JR

ROY KING 
SUPERVISORY PATENT EXAMINER
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